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[10191/1284]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Examiner: Y. Lee
Michael WOLLBORN	Art Unit 2613
For: METHOD OF FORMATTING A DATA FLOW BY CODING BASED ON THE SEQUENCE OBJECTS OF ANIMATED IMAGES	
Filed: May 10, 2000	
Serial No. 09/485,816	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313

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Date: March 30, 2005

Signature: _____

APPEAL BRIEF TRANSMITTAL

S I R:

In response to the "Notification of Non-Compliant Appeal Brief (37 CFR 41.37)," dated March 1, 2005, transmitted herewith for filing in the above-captioned patent application is an Appeal Brief Pursuant to 37 C.F.R. § 41.37. The Appeal Brief fee was believed to have been charged to the deposit account of Kenyon & Kenyon, Deposit Account No. **11-0600**, by the filing of the original Appeal Brief on December 3, 2004.

Accordingly, no fees are believed to be required in connection with the filing of this Appeal Brief. If any fees are required, the Commissioner is authorized to charge any such fees to the deposit account of Kenyon & Kenyon, Deposit Account No. **11-0600.**

Respectfully submitted,

Dated: March 30, 2005 By: _____

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[10191/1284]

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APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

S I R:

In the above-captioned application ("the present application"), Appellants mailed a Notice of Appeal on May 7, 2004 from the Final Office Action mailed by the United States Patent and Trademark Office on January 16, 2004. In the Final Office Action, claims 5 to 8 were finally rejected.

A "Reply Under 37 C.F.R. § 1.116" was filed on March 23, 2004 in response to the Office Action, and an Advisory Action was mailed by the United States Patent and Trademark Office on April 1, 2004.

This Appeal Brief is being filed in response to the "Notification of Non-Compliant Appeal Brief (37 CFR 41.37)," dated March 1, 2005.

This Appeal Brief is being submitted in support of the appeal of the final rejections of claims 5 to 8. It is respectfully submitted that the final rejections of claims 5 to 8 should be reversed for the following reasons.

I. Real Party in Interest

The real party in interest in the present appeal is Robert Bosch GmbH of Stuttgart, Federal Republic of Germany, the assignee of the entire right, title and interest in and to the present application.

II. Related Appeals and Interferences

There are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellants or the assignee, Robert Bosch GmbH, "which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal."

III. Status of Claims

Claims 1 to 4: Canceled.

Claims 5 to 8: Rejected.

The claims on appeal in the present appeal are claims 5 to 8.

Claims 5 to 8 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over that which the Final Office Action characterizes as "admitted prior art."

IV. Status of Amendments

A "Reply Under 37 C.F.R. § 1.116" was filed on March 23, 2004 in response to the Final Office Action dated January 16, 2004. The "Reply Under 37 C.F.R. § 1.116" included no proposed amendments to the claims.

V. Summary of Claimed Subject Matter

The methods of the present invention are applicable to data stream processing for object-based coding of moving image sequences with any size and shape. (Specification, page 1, lines 3 to 5).

In an exemplary method of the present invention, less data is transmitted for a non-coded video object, e.g., for a video object that is not to be displayed immediately. A definite element is used for signaling the state of whether or not a video object is to be displayed. Additionally, the coded/not coded state is transmitted and signaled for rectangular video objects. (Specification, page 3, lines 5 to 16).

An exemplary method of the present invention involves inserting signaling information indicating whether a video object is coded or not coded before or after local time base information in a data stream. When the signaling information is inserted before the local time base information, even less data need be transmitted for a non-coded video object plane than when the signaling information is inserted after the local time base, because in this case the local time base information is not transmitted. Also, in this case, the "blanking out," e.g., suppression of the display of a video object, is no longer possible at a very specific point in time, but instead it may only take place at the next time following the receipt of the non-coded video object plane, when an image is displayed at the receiver end. (Specification, page 3, lines 18 to 30).

The present invention is also directed to a method for processing a data stream for object-based coding of moving image sequences for video objects having any size and shape, including: inserting a local time base information before an actual information on a video object, and inserting signaling information, indicating whether the video object is to be

decoded for playback or displayed, into the data stream one of before and after the time base information, regardless of an external form of the video object. (See claim 5).

The present invention is further directed to the foregoing features, and to the further features of: wherein the signaling information indicates a coded state and a non-coded state for the video object, and including terminating a transmission of information on the video object for the non-coded state and suppressing a display for the video object. (See claim 6).

The present invention is further directed to the foregoing features, and to the further features of: for video objects whose signaling information corresponds to the non-coded state, no longer displaying a corresponding video object at a time determined by the local time base information. (See claim 7).

The present invention is further directed to the foregoing features, and to the further features of: for video objects whose signaling information corresponds to the non-coded state, no longer displaying a corresponding video object at a next time when there is to be a display after a time determined by the local time base information. (See claim 8).

Claim 5 is the only independent claim involved in the present appeal. Claim 5 relates to a method for processing a data stream for object-based coding of moving image sequences for video objects having any size and shape. Figure 2 illustrates the structure of the data stream for the transmission of video objects. Specification at page 4, lines 3 to 4. The method includes inserting a local time base information (e.g., "modulo_time_base" illustrated in Figure 2) before an actual information on a video object (e.g., "VideoObject 1," "VideoObject 2," . . . "VideoObject n" illustrated in Figure 2). Specification at page 4, lines 4 to 20. The method also includes inserting signaling information

(e.g., "VOP_coded" illustrated in Figure 2), indicating whether the video object is to be decoded for playback or displayed, into the data stream (illustrated, e.g., in Figure 2) one of before and after the time base information (e.g., "modulo_time_base" illustrated in Figure 2), regardless of an external form of the video object. Specification at page 4, lines 22 to 27. Figure 2 illustrates the structure of the data stream for the time base signaling information (e.g., "VOP_coded") being inserted after the time base information (e.g., "modulo_time_base"), and Figure 3 illustrates the time base signaling information (e.g., "VOP_coded") being inserted before the time base information (e.g., "modulo_time_base").

VI. Grounds of Rejection

The ground of rejection for review is:

1. Whether, under 35 U.S.C. § 103(a), claims 5 to 8 are unpatentable over that which the Final Office Action characterizes as "admitted prior art."

VII. Argument

Rejection of Claims 5 to 8 Under 35 U.S.C. § 103(a)

Claims 5 to 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over that which the Final Office Action characterizes as "admitted prior art." Appellants respectfully submit that that which the Final Office Action characterizes as "admitted prior art" does not render unpatentable claims 5 to 8, and Appellants therefore respectfully request reversal of the present rejection.

As an initial matter, Appellants do not concede that Figure 1 illustrates "prior art." Contrary to the position apparently taken in the Final Office Action, the mere reference to Figure 1 in the section of the present application captioned "Background Information" does not constitute an admission that Figure 1 represents "prior art"

with the meaning of the patent statute. None of the Office Actions to date have otherwise established that Figure 1 illustrates "only that which is old." Accordingly, it is respectfully submitted that the present rejection should be reversed for this reason alone.

Notwithstanding the foregoing, it is respectfully submitted that, even if the Final Office Action is correct in characterizing Figure 1 as prior art, claims 5 to 8 not rendered unpatentable by Figure 1 and that, consequently, the present rejection should be reversed.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 5 recites, inter alia, that a method for processing a data stream for object-based coding of moving image sequences for video objects having any size and shape includes "inserting signaling information, indicating whether the video object is to be decoded for playback or displayed, into the data stream one of before and after the time base information, regardless of an external form of the video object." As regards this inserting, the Office Action dated

May 6, 2003 admitted at page 4 that the "admitted prior art" "fails to particularly discloses [sic] inserting an additional signaling information (VOP_coded) as specified in claims 5-8" and stated at page 4 that "[the] Examiner takes Official Notice that such signal insertion feature is notoriously well known in the art that unless by shifting of insertion location produces novel and/or unexpected results, it is merely considered as well known design option that is obvious to one of ordinary skill in the art because varying the 'next_strart_code' function call provides no significant functional or patentable differences." The "Official Notice" and other allegations of well-known fact were timely and adequately traversed in the "Response" filed on November 6, 2003. Despite Appellants' traverse of the "Official Notice" and other allegations of well-known fact and Appellants' demand for an affidavit under 37 C.F.R. § 1.104(d)(2) and/or published information concerning the unsupported "Official Notice" and allegations of well-known fact, no such affidavit or published information was provided. Rather, the Final Office Action merely reasserted at page 3 that "[w]ith respect to . . . inserting the signaling information before or after the time base information, it is submitted that such signal insertion feature is notoriously well known in the art that unless by shifting of insertion location produces novel and/or unexpected results, it is only considered as well known design option that is obvious to one of ordinary skill in the art because merely to shift location of a function call provides no significant functional or patentable differences." Appellant again traversed the unsupported allegations of well-known fact in the "Reply Under 37 C.F.R. § 1.116" filed on March 23, 2004. However, to date no affidavits or other published information has been presented in any Office Action to support the otherwise unsupported allegations of well-known fact.

It is inappropriate "for an examiner to take official notice of facts without a prior art reference whether the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." M.P.E.P. § 2144.03. As made clear in the decision of In re Ahlert, 424 F.2d 1088, 165 U.S.P.Q. 418 (C.C.P.A. 1970):

> Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. . . . **Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.**

In re Ahlert, 424 F.2d. at 1091, 165 U.S.P.Q. at 420 to 421 (citations omitted).

Additionally, the Final Office Action asserted at page 4 that "it would have been obvious to one of ordinary skill in the art at the time the invention was made, to exploit the common knowledge of inserting signaling information in the processing method of Applicant's admitted prior art in order to more efficiently process video objects having any size and shape." The Board's attention is directed to the Federal Circuit decisions of In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) and In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001), which found that deficiencies of cited references could not be remedied by general conclusions about what is asserted to be "basic knowledge" or "common sense." In re Lee, 61 U.S.P.Q.2d at 1435 (common knowledge and common sense do not substitute for authority when the law requires authority; when an examiner and the Board rely on what is asserted to be general knowledge to negate patentability, that knowledge must be articulated

and placed on the record; final rejection reversed); In re Zurko, 59 U.S.P.Q.2d at 1697 (assessment of basic knowledge and common sense that was not based on any evidence in the record lacks substantial evidence support; final rejection reversed).

It is respectfully submitted that " inserting signaling information, indicating whether the video object is to be decoded for playback or displayed, into the data stream one of before and after the time base information, regardless of an external form of the video object" is not merely a matter of "design option." Rather, as stated at page 3, lines 12 to 17 of the Specification, for example, "[i]f the signaling information is inserted before the local time base information, even less data need be transmitted for a non-coded VOP than when the signaling information is inserted after the local time base, because in this case the local time base information is not transmitted."

In view of all of the foregoing, it is respectfully submitted that that which the Final Office Action characterizes as "admitted prior art" does not render unpatentable claim 5.

As for claims 6 to 8, which depend from claim 5 and therefore include all of the limitations of claim 5, it is respectfully submitted that that which the Final Office Action characterizes as "admitted prior art" does not render unpatentable these dependent claims for at least the same reasons more fully set forth above with respect to claim 5. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious.

In summary, it is respectfully submitted that claims 5 to 8 are not rendered unpatentable by that which the Final Office Action characterizes as "admitted prior art." Reversal of this rejection is therefore respectfully requested.

VIII. Claims Appendix

An appendix containing a copy of the claim involved in the present appeal is attached hereto.

IX. Conclusion

In view of the above, it is respectfully requested that the rejection of claims 5 to 8 be reversed and that these claims be allowed as presented.

Respectfully submitted,

Dated: March 30, 2005

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CLAIMS APPENDIX

5. A method for processing a data stream for object-based coding of moving image sequences for video objects having any size and shape, comprising the steps of:

inserting a local time base information before an actual information on a video object; and

inserting signaling information, indicating whether the video object is to be decoded for playback or displayed, into the data stream one of before and after the time base information, regardless of an external form of the video object.

6. The method according to claim 5, wherein the signaling information indicates a coded state and a non-coded state for the video object, and further comprising the steps of:

terminating a transmission of information on the video object for the non-coded state; and

suppressing a display for the video object.

7. The method according to claim 5, further comprising the step of, for video objects whose signaling information corresponds to the non-coded state, no longer displaying a corresponding video object at a time determined by the local time base information.

8. The method according to claim 5, further comprising the step of, for video objects whose signaling information corresponds to the non-coded state, no longer displaying a corresponding video object at a next time when there is to be a display after a time determined by the local time base information.